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In re Application of
ZALEVSKY et al.
U.S. Application No.: 10/565,623
PCT No.: PCT/IL2004/00678
International Filing Date: 25 July 2004
Priority Date: 24 July 2003
Atty's Docket No.: ZALEVSKY4
For: METHOD FOR PRODUCTION
OF MICRO-OPTICS STRUCTURES

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: DECISION ON PETITION
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: UNDER
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: 37 CFR 1.497(d), 1.183 and 1.47(a)
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This decision is issued in response to applicant's petitions: "Petition under 37 CFR 1.497(d)", "Petition under 37 CFR 1.183" to waive the requirements of 37 CFR 1.497(d), and "Petition under 37 CFR 1.47(a)" filed 05 December 2006. The appropriate petition fees were paid. Applicant's request for a five month extension of time is granted.

BACKGROUND

On 25 July 2004, applicant filed international application PCT/IL04/00678. The international application claimed a priority date of 24 July 2003 and it designated the United States. On 3 February 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO).

The deadline for submission of the basic national fee was thirty months from the priority date, i.e. 24 January 2006. The published international application identified five inventors: Zeev Zalevsky, Vardit Eckhouse, Izhar Eyal, Arkady Rudnitsky and Nadav Cohen.

On 24 January 2006, applicant filed a Transmittal Letter for entry into the national stage in the United States accompanied by, *inter alia*, payment of the basic national fee.

On 5 May 2006, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicant requiring submission of a proper declaration under 37 CFR 1.497(a) and (b) and the surcharge for filing the declaration later than thirty months after the priority date.

On 5 December 2006, in response to the 905, applicant filed a declaration, which listed Yuval Kapellner as an inventor. The declaration is unacceptable as it fails to properly identify the inventors of record herein because Mr. Kapellner is not identified as an inventor in the published PCT international application. Applicant also filed a petition under 37 CFR 1.497(d), a Petition under 37 CFR 1.183 and a petition under 1.47(a). The petition under 37 CFR 1.497(d) seeks to add Yuval Kapellner as an inventor; the petition under 37 CFR 1.183 seeks waiver of the requirement of 37 CFR 1.497(d)(1). The petition under 37 CFR 1.47(a) requests the application

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to be accepted without the signatures of Izhar Eyal, Arkady Rudnitsky and Yuval Kapellner.

On 25 May 2007, a Notification of Acceptance was erroneously mailed to applicant and is hereby VACATED.

DISCUSSION

Request To Add Inventor Under 37 CFR 1.497(d)

Where, as here, the filed declaration names additional inventors who were not identified on the international application, 37 CFR 1.497(d) requires applicant to submit: (1) a statement from each person being added as an inventor that any error in inventorship in the international application occurred without deceptive intent; (2) the processing fee; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the consignee (in the form required by 37 CFR 3.73(b)).

Applicant has submitted the required processing fee, satisfying Item (2). Applicant has provided the consent of the assignee, Ex-Play, LTD to the requested change of inventorship, satisfying Item (3). However, Applicant has not provided the statement from Mr. Kapellner, required under 37 CFR 1.497(d)(1). In lieu of the statement, applicant submits a petition under 37 CFR 1.183 to waive the requirement under 37 CFR 1.497(d)(1).

Petition under 37 CFR 1.183

Because of Mr. Kapellner's alleged refusal to sign a statement of lack of deceptive intent, applicant filed a petition under 37 CFR 1.183 to waive this requirement.

Petitioner contends that Yuval Kapellner was intended to be included as an inventor in the PCT application but his name was inadvertently listed as an applicant for other than the U.S. In support of this contention, Petitioner relies on an email communication from Mr. Kapellner to Devin Katz, patent administrator for an Israeli law firm, who prepared the Request form for PCT/IL02/00678. Petitioner relies on Exhibit P, which is attached to the Katz declaration and referenced therein, to confirm that Mr. Kapellner identifies himself as an inventor for the application at issue. However, the email does not identify PCT/IL02/00678 but is directed to a European Patent application. Moreover, it is noted that the email is signed by Yuval Kapplener-Rabinovitch, not Yuval Kapellner. It is noted that Exhibit K, a letter indicating Kapplener-Rabinovitch's willingness to assign PCT/IL04/00951, is also included among the papers requesting relief under 37 CFR 1.47(a). Given the difference in the spelling and hyphenated name (Kapellner or Kapplener-Rabinovitch), it is unclear whether the signatory in these Exhibits one and the same person as the nonsigning inventor referred to as Kapellner.

Applicant attempts to rely on an analogous context of 37 CFR 1.48(a) and cites MPEP section 201.03(II)(A) with respect to applicant's possible alternatives, based on this alleged refusal to execute the 37 CFR 1.497(d)(1) statement required to add him as an inventor.

As discussed in MPEP section 201.03(II)(A), where an inventor to be added or deleted refuses to execute the required statement of non-deceptive intent, the applicants have two options. They can either: (1) file a petition under 37 CFR 1.183 requesting waiver of the requirements of 37 CFR 1.497(d)(1); or (2) file a continuation application that names the proper inventors (i.e., the inventors of record, plus Mr. Kapellner), thereby alleviating the necessity of adding the missing inventor to the application under 37 CFR 1.497(d).

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A petition under 37 CFR 1.183 is only granted in rare circumstances¹ where justice requires the waiver of the applicable regulation and where applicants have no alternative remedy.

Applicant states that there is a difficulty in adding Mr. Kapellner as an inventor herein, because any such request requires a statement under 37 CFR 1.497(d)(1) executed by Mr. Kapellner, who purportedly refuses to execute any documents for this application. Applicant argues that waiver under 37 CFR 1.183 may be available in situations where an inventor to be added refuses to submit a statement supporting the addition or such party cannot be reached, citing MPEP Section 201.03 II A . Statement of Lack of Deceptive Intention.

In the analogous context of a petition under 37 CFR 1.48, section 201.03(II)(A) of the MPEP addresses situations where the required statement from an added inventor cannot be obtained. The MPEP states that, on "very infrequent occasions", the statement requirement can be waived pursuant to a petition under 37 CFR 1.183. The MPEP goes on to suggest an alternative remedy, as follows:

An available remedy to obtain correction of inventorship where waiver of a required statement is not available to correct the inventorship in a particular application is to refile the application naming the correct inventive entity. A request under 37 CFR 1.48(a) would not then be required in the newly filed application as no correction would be needed. Furthermore, a request under 37 CFR 1.48(a) would also not be required in the prior application that was refiled, since the prior application will be abandoned. Benefit of the parent application's filing date would be available under 35 U.S.C. 120 provided there is at least one inventor overlap between the two applications. (Note: a sole-to-sole correction would not obtain benefit under 35 U.S.C. 120).

Applicant has not provided a rare factual scenario, unequivocally supporting the correction sought, to require a waiver of the rule. For this reason, the petition under 37 CFR 1.183 is **DISMISSED without prejudice.**

Therefore, the present record does not include all the requirements for the requested addition of Mr. Kapellner an inventor herein. Applicant states that the inventor has refused to sign the statement required under 37 CFR 1.497(d)(1); however, such a refusal does not eliminate the applicable requirement. The requirements of 37 CFR 1.497(d) are not met and the petition to add Yuval Kapellner as an inventor is **DISMISSED without prejudice.**

¹ As noted in MPEP §201.03, on very infrequent occasions, the requirements of 37 CFR 1.48(a) have been waived upon the filing of a petition and fee under 37 CFR 1.183 (along with the request and fee under 37 CFR 1.48(a)) to permit the filing of a statement by less than all the parties required to submit a statement. However, such a waiver will not be considered unless the facts of record unequivocally support the correction sought. 37 CFR 1.48(a) is intended as a simple procedural remedy and does not represent a substantive determination as to inventorship, issues relating to the inventors' or alleged inventors' actual contributions to conception and reduction to practice are not appropriate for consideration in determining whether the record unequivocally supports the correction sought.

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Petition under 37 CFR 1.47(a)

Applicant also filed a petition under 37 CFR 1.47(a) requesting that the application to be accepted without the signatures of Izhar Eyal, Arkady Rudnitsky and Yuval Kapellner².

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1) is satisfied with the payment of the petition fee. Item (2) is satisfied with the declaration of Svetlana Shtadler, who sent each nonsigning inventor a complete copy of the application. Attached to Ms. Shtadler's declaration are copies (and English translations) of the postal receipt, confirming delivery of the application to the nonsigning inventors. From this evidence and the inventors' conduct, it can be concluded that the nonsigning inventors refuse to sign the application papers. Item (3) is satisfied because the last known addresses of the nonsigning inventors was provided. Item (4) cannot be satisfied with the declaration executed by the joint inventors on behalf of the nonsigning inventors until the inventorship of the application is resolved.

However, the petition under 37 CFR 1.47(a) cannot be granted at this time, until the inventorship of the application is resolved. The declaration submitted identifies an inventive entity, which is not named in the international application and is unacceptable at this time. The petition under 37 CFR 1.47(a) is held in abeyance until the inventorship of the application is resolved.

CONCLUSION

The 25 May 2007 Notification of Acceptance was erroneously mailed to applicant and is **VACATED**.

Applicant's request to correct inventorship under 1.497(d) and petition under 37 CFR 1.183 is **DISMISSED without prejudice**.

Applicant's petition under 37 CFR 1.47(a) is **DISMISSED without prejudice**.

The declaration filed 05 December 2006 is defective for failure to properly identify the inventors of record herein.

If reconsideration on the merits of the petitions is desired, a proper response must be filed within TWO (2) MONTHS of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d) and 1.47(a)" and must include the statement from Yuval Kapellner required under 37 CFR 1.497(d)(1), as discussed above.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

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Please direct further correspondence with respect to this matter to Mail Stop PCT,
Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria,
Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT
Legal Administration.

A handwritten signature in cursive script, appearing to read "Leonard E. Smith".

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